



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/564,761	01/17/2006	Tatsushi Ogawa	040894-7374	1486

9629 7590 03/26/2007  
MORGAN LEWIS & BOCKIUS LLP  
1111 PENNSYLVANIA AVENUE NW  
WASHINGTON, DC 20004

EXAMINER
----------

BRAKEWOOD, CANDACE ELIZABETH

ART UNIT	PAPER NUMBER
----------	--------------

3721

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/26/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/564,761	<b>Applicant(s)</b> OGAWA ET AL.	
	<b>Examiner</b> Candace Brakewood	<b>Art Unit</b> 3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 26 December 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 December 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is in response to applicants' amendment received on December 26, 2006.

#### ***Drawings***

2. The replacement drawing sheets received on December 26, 2006 are acknowledged and accepted.

#### ***Specification***

3. The amendment to page 7 of the specification received on December 26, 2006 is acknowledged and accepted.
4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. The new claims 8-16 use terminology not found in the specification, such as the terms "first position", "second position", "first outer dimension", "third and fourth ends", "first passage", etc. Correction is required. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o).
5. The title of the invention is not descriptive. While it identifies the field of invention, it does not reflect the actual improvement to the nailing machine. A new title is required that is clearly indicative of the invention to which the claims are directed. The following title is suggested: *Cylindrical Contact Arm having a Tapered Guide Section in a Power-driven Nailing Machine*.

#### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 3721

7. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1 and 8, it is not clear what the phrase "maximum sized nail" encompasses.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-16 are rejected under 35 U.S.C. 102(b) as being anticipated by the applicant's admitted prior art (hereinafter APAA), JP-A-2002-337066, which is now US Patent No. 6,578,750 (the US Patent is cited for translation purposes, and hereinafter, all cited reference numbers are from this patent).

Claims 1-4 are rejected for the same reasons set forth in paragraph 12 of the previous Office Action, paper no. 20061002.

Regarding claim 5, a trigger (33) activates the driving piston (Fig. 1, Fig. 2).

With respect to claim 6, the contact nose (36) is movable relative to the nose body (26), and in one configuration, the nose body blocks movement of the contact nose (Fig. 6).

Regarding claim 7, the driving piston is driven by compressed air (column 3, line 16).

Art Unit: 3721

Regarding claim 8, as is best understood given the claim terminology not found in the specification, the driving cylinder has a longitudinal axis (through driver, 23), and the driving piston (24) has a first position (the upper, non-actuated position) and a second position (the lower, actuated position). The driver has first (upper) and second (lower) ends, where the second end has a first outer dimension (circumference). The nose body (26) has third and fourth ends (Fig. 1) and includes a first passage (Fig. 1) with a first inner dimension, which is greater than the first outer dimension (Fig. 1). A nail supply mechanism (28) accommodates what is deemed to be a maximum sized nail. A contact nose (36) includes a hollow member (45) that has proximal and distal ends (Fig. 1), inner and outer surfaces (Fig. 1), and is slidable relative to the nose body (26). A guide portion (36) forms a radial enclosure aligned with at least one nail.

With respect to claims 9 and 10, the guide portion includes a tapered face (the topmost part of 36, Fig. 6) and the radial enclosure includes a straight guide portion (Fig. 6).

Claims 11 and 12 have been previously addressed in regard to claims 5 and 6, respectively.

Regarding claim 13, a grip (20) is connected to the driving cylinder.

With respect to claims 14 and 15, a chamber (31) for stored air is in the grip (20) and the compressed air drives the driving piston (column 3, line 16).

Regarding claim 16, the driver (3) extends through the passage in the nose body and into the contact nose (Fig. 8).

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the AAPA, JP-A-2002-337066, which is now US Patent No. 6,578,750, in view of Kristiansen (1,241,996).

Claims 1-4 are rejected for the same reasons as set forth in paragraph 12 of the previous Office Action, *supra*.

Regarding claims 5-16, if it is argued that the guide portion of the AAPA is not "longer than a maximum sized nail", i.e. the portion is shorter than the length of the nail, Kristiansen shows a nose portion (11) having a guide portion (12) with a length longer than the nail (13) for the purpose of ensuring proper guidance of the nail during the driving operation. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to have provided the AAPA with a portion having a length greater than the length of the nail to be driven in order to ensure proper guidance of the nail during the driving operation.

***Response to Arguments***

12. Applicant's arguments filed December 26, 2006 have been fully considered but they are not persuasive.

First, the applicants contend the rejection under 35 U.S.C. 112, second paragraph, regarding the clarity of the phrase "maximum sized nail". Even in light of the specification, the examiner maintains that it is unclear what the phrase encompasses, because claims 1 and 8 do not specify a specific nail length. Therefore, given the broadest reasonable interpretation, any nail with a length shorter than the guide portion is suitable, and any such nail is deemed to be "maximum sized".

Next, the applicants argue that the AAPA does not disclose a guide portion longer than a maximum sized nail. The examiner asserts that claims are given their broadest reasonable interpretation, and as previously stated, any nail shorter than the guide portion is deemed suitable, and the nailing machine of the AAPA is deemed capable of functioning with such a nail.

The applicants further contend that the AAPA do not recite "a cylindrical portion" or "a second tapered guide portion". On the contrary, the AAPA includes a cylindrical portion (36 and the bottom section of 37, Fig. 6), and a second tapered guide portion (45, Fig. 6).

Next, the applicants argue that one of ordinary skill in the art would not be motivated to combine Kristiansen ('996) with the AAPA because the foot disclosed by Kristiansen ('996) is fixed with respect to the hammer guide, whereas the contact nose and nose body in the AAPA move with respect to each other. As both of these references are in the same field of endeavor, i.e. nosepieces for nailing machines, and they both are pertinent to the problem of proper nail alignment during firing, the combination of the references is held to be obvious to one of ordinary skill in the art.

Art Unit: 3721

Lastly, the applicants contend that Kristiansen ('996) is silent as to the length of the outlet relative to the maximum sized nail used with the tool. The examiner cites Fig. 4 of Kristiansen ('996) to show the length of the outlet being greater than the length of the nail used in the tool. Additionally, as previously stated, given the broadest reasonable interpretation of the claim language, any nail with a length shorter than the guide portion is sufficient, and any such nail is deemed to be "maximum sized".

For the reasons above, the grounds of rejection are deemed proper.

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Mukoyama et al. (6,145,727), Blomquist, Jr. (5,205,457), Fealey (5,263,842), Ishizawa (5,647,525) and Hamada et al. (6,695,196) are cited to show related inventions.

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

15. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of



Art Unit: 3721

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

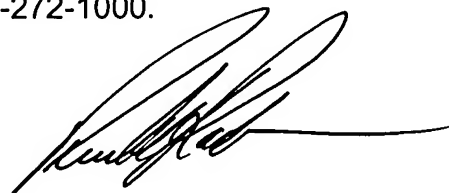
16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Candace Brakewood whose telephone number is 571-272-3115. The examiner can normally be reached on Monday-Thursday, 7am-5:30pm.

17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Candace Elizabeth Brakewood  
Examiner  
Art Unit 3721  
March 20, 2007



Rinaldi I. Rada  
Supervisory Patent Examiner  
Group 3700